

REMARKS

In response to the final Office Action dated 6 October 2004, the applicant requests reconsideration of the above-identified application in view of the following remarks. Claims 1-33 are pending in the application. Claims 1, 3-5, 8-18, 20-23, 25-29, and 31-33 are rejected, and claims 2, 6, 7, 19, 24 and 30 are objected to. None of the claims has been amended.

Allowable Subject Matter

The final Office Action indicated that claims 2, 6, 7, 19, 24 and 30 would be allowable if rewritten in independent form. The applicant reserves the right to rewrite claims 2, 6, 7, 19, 24 and 30 in independent form, but believes that the base claims from which they depend are allowable in view of the remarks presented below.

Information Disclosure Statement

The applicant filed an Information Disclosure Statement on 10 June 2004. The applicant respectfully requests entry of that Information Disclosure Statement and requests that the documents listed on the attached Form 1449 be considered by the Examiner and made of record. Pursuant to the provisions of MPEP 609, the applicant requests that a copy of the 1449 form, initialed as being considered by the Examiner, be returned to the applicant with the next official communication.

Rejections of Claims Under §103

Claims 1, 3-5, 8-13, 15-16, 18, 20-23, 25-29, and 31-33 were rejected under 35 USC § 103(a) as being unpatentable over Daniel et al. (U.S. Patent No. 6,075,484, Daniel) in view of Yun (U.S. Patent No. 6,463,295) and Keskitalo et al. (U.S. Patent No. 6,345,188, Keskitalo). The applicant respectfully traverses.

The applicant filed a response to this rejection with remarks on 10 June, 2004, and incorporates those remarks herein. In addition, the applicant addresses herein the “Response to Arguments” of the final Office Action dated 6 October 2004.

Referring to the applicant's remarks of 10 June, 2004, the applicant respectfully submits that, even as combined, Daniel, Yun, and Keskitalo do not show all of the elements recited in claim 1.

The final Office Action provided several motivations for combining Daniel, Yun, and Keskitalo, but did not provide evidence of motivation in the prior art as is required by *In re Vaeck* and *In re Lee*. For example, addressing claims 1, 16, 22, 28, and 31, the final Office Action states that “[i]t would have been obvious to modify Daniel, such that power control is supported for a multi-array antenna, to provide control of RF power output for optimal transmission of the RF signal and decrease interference with other transmitters.”¹ With reference to Keskitalo, the final Office Action states that “[i]t would have been obviousto modify Daniel in view of Yun, such that wireless transmission for an antenna array with power control also uses antenna array gain parameters to steer the beam in a certain direction, to provide optimal RF communication based on steering the array, antenna gain and power control parameters.”² The Office Action did not identify any prior art evidence as the source of these suggestions for modifying Daniel, as is required by *In re Vaeck* and *In re Lee*. The final Office Action indicates that “the examiner has provided two motivation statements regarding the combination of Daniel, Yun and Keskitalo.”³ These statements must be supported by evidence in the prior art, and none has been supplied.

The applicant respectfully submits that a prima facie case of obviousness of claims 1, 3-5, 8-13, 15, 16, 18, 20-23, 25-29 and 31-33 has not been established in the Office Action, and that claims 1, 3-5, 8-13, 15, 16, 18, 20-23, 25-29 and 31-33 are in condition for allowance.

Claim 14 was rejected under 35 USC § 103(a) as being unpatentable over Daniel, Yun and Keskitalo, and further in view of Liebendoerfer et al. (U.S. Patent No. 5,943,020, Liebendoerfer). The applicant respectfully traverses.

The final Office Action states that “[i]t would have been obvious to modify Daniel in view of Yun and Keskitalo, such that the common structure is adapted for desktop placement, to

¹ Final Office Action, page 2.

² Final Office Action, pages 2-3.

³ Final Office Action, page 3.

provide a small antenna system for use by mobile users.”⁴ The final Office Action did not identify any prior art evidence as the source of this suggestion for modifying Daniel, as is required by *In re Vaeck* and *In re Lee*.

The final Office Action states that:

“the applicant does not point out WHY one skilled cannot use the prior art in a desktop application.... “where in any of the references does it specifically state that one cannot use an antenna disclosed by the prior art in a desktop application?”. The examiner points out that none of the prior art references prevent such an application. Hence the motivation is clear and the combination is valid.”⁵

The MPEP states the following with respect to a *prima facie* case of obviousness:

“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.”⁶

And:

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”⁷

The applicant respectfully submits that the final Office Action has not met the initial burden of factually supporting a *prima facie* case of obviousness because there is no evidence that the prior art suggests the desirability of the combination of Daniel, Yun, Keskitalo, and Liebendoerfer. The applicant respectfully submits that a *prima facie* case of obviousness of claim 14 has not been established in the final Office Action, and that claim 14 is in condition for allowance.

Claim 17 was rejected under 35 USC § 103(a) as being unpatentable over Daniel, Yun and Keskitalo, and further in view of Roddy et al. (U.S. Patent No. 6,127,740, Roddy). The applicant respectfully traverses.

The final Office Action states that “[i]t would have been obvious to modify Daniel in view of Yun and Keskitalo, such that a duty cycle unit is used to determine average transmit duty

⁴ Final Office Action, page 3.

⁵ Final Office Action, page 3.

⁶ MPEP 2142, page 2100-128.

⁷ MPEP 2143.01, page 2100-131.

cycle, to provide means for the PCU to adjust transmit power level as needed for optimal wireless transmission/reception.”⁸ The final Office Action did not identify any prior art evidence as the source of this suggestion for modifying Daniel as is required by *In re Vaeck* and *In re Lee*.

The final Office Action made remarks for claim 17 similar to those made for claim 14, and the applicant respectfully submits that the final Office Action has not met the initial burden of factually supporting a *prima facie* case of obviousness because there is no evidence that the prior art suggests the desirability of the combination of Daniel, Yun, Keskitalo, and Roddy. The applicant respectfully submits that a *prima facie* case of obviousness of claim 17 has not been established in the final Office Action, and that claim 17 is in condition for allowance.

⁸ Final Office Action, page 4.

RESPONSE UNDER 37 C.F.R. 1.116 – EXPEDITED PROCEDURE

Serial Number: 09/652,773

Filing Date: August 31, 2000

Title: TRANSMIT POWER CONTROL WITHIN A WIRELESS TRANSMITTER

Assignee: Intel Corporation

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Dkt: 884.313US1 (INTEL)

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 612-373-6973 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

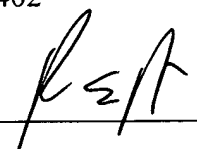
Respectfully submitted,

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Date 19 JANUARY 2005

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 19th day of January, 2005.

Name

Amy Moriarty

Signature

